



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,534	09/19/2000	Yasuyuki Yoshimura	423-P-027	5261

7277 7590 04/22/2003

HOWARD C. MISKIN  
C/O STOLL, MISKIN, HOFFMAN & BADIE  
EMPIRE STATE BUILDING  
350 FIFTH AVE., STE. 6110  
NEW YORK, NY 10118

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 04/22/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/665,534

Applicant(s)

YOSHIMURA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-33 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/28/03 has been entered.

2. All outstanding rejections are overcome by applicants' amendment filed 1/28/03.

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-26 and 29-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 19-20, 23-24, 29-30, and 32-33 each recite that the glittering particles have a "smooth metal surface". It is the examiner's position that this phrase fails to satisfy the written description requirement under the cited statute since there does not appear to be a written

description requirement of the phrase "smooth metal surface" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed

It is suggested that the phrase "smooth metal surface" is deleted from each of claims 1, 19-20, 23-24, 29-30, and 32-33.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12, 19-26, and 29-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 12, which depends on claim 1, recites that the ink comprises "binder component for fixing the said scaly glittering particles to a written mark or a coated film". However, this limitation is already found in claim 1 and thus, it is not clear what the difference is between claim 12 and claim 1.

It is suggested that claim 12 is cancelled.

**NOTE:** If claim 12 is cancelled, the dependencies of claim 13 and 18 must be changed since they presently depend on claim 12. It is further noted that if the dependency of claim 18 is changed to claim 1, it will then be identical to claim 11.

(b) Claim 30 appears to be identical to claim 1 and thus, it is not clear what the difference is between the claims. Clarification is requested.

(c) Claim 19, line 4, recites “scaly glittering particles” while lines 1 and 2 of the claim recite “glittering particles”. The scope of the claim is confusing because it is not clear if the written mark comprises two types of particles or if the two different recitations refer to the same particle. Clarification is requested. If the latter is true, it is suggested that “scaly” is inserted in line 1 after “comprising” and before “glittering” while in line 2 after “wherein” and before “glittering” and in line 4, after “to” and before “scaly”, “the “ is inserted in order to ensure proper antecedent basis.

The same questions arise in claims 20, 23, 24, 29, and 33 which each recites the same claim language as claim 19.

(d) Claim 19 recites “the coating ratio of a colorant to scaly glittering particles to said median diameter is not greater than 80%”. The scope of the claim is confusing in light of the disclosure on, for instance, page 5 of the present specification as well as the recitation in present claim 1 given that in the specification and in present claim 1, surface coating ratio is defined as the coating ratio of the colorant which covers the surface of the glittering particle. There is no disclosure that the median diameter is a parameter of the coating ratio. Should the phrase “to said median diameter” be deleted from the claim?

Similar questions arise in claims 20, 29, and 33 which each also recite that the coating ratio includes the median diameter.

(e) Claim 19 recites “the coating ratio of a colorant to scaly glittering particles”.

However, as set forth on page 5 of the present specification, it is the “surface coating ratio” of a colorant on the particle surface which is not greater than 80%. The surface coating ratio is defined as a coating ratio of the colorant which covers the surface of the glittering particle. In light of this disclosure, should “coating ratio” be changed to “surface coating ratio” in claim 19? Clarification is requested.

Similar questions arise in claims 20, 23, 24, 29, and 33 which each also recite “coating ratio” similar to claim 19.

(f) Claims 23 and 24 each recite the limitation “the aqueous glittering ink” in line 1.

There is insufficient antecedent basis for this limitation in the claim. It is suggested that the phrase is changed to “an aqueous glittering ink”.

(g) Claim 32 recites an improper Markush group. It is suggested that the phrase “the group consisting of” is inserted after “from” and before “flaky” in line 2.

**Claim Rejections - 35 USC § 103**

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10077438 in view of EP 600205.

JP 10077438 discloses an aqueous-based ink for pens wherein the ink comprises water, 1-10% pigment particle such as mica coated with titanium oxide or iron oxide that has diameter of 5-60  $\mu\text{m}$ , 30% solvent, 0.1-10% colorant, and 0.1-3% water-soluble resin (paragraphs 4-7, and 10).

It is disclosed that as shear rate increases, viscosity decreases so that the ink is clearly pseudoplastic. Further given that the ink is pseudoplastic and given that at 1 rpm, the viscosity ranges from approximately 1,000-9,000 mPa s, it is clear that at 0.5 rpm, the viscosity will be greater than the viscosity at 1 rpm and thus meet the requirements of the present claims (Table 2).

Although there is no explicit disclosure that the ink is glittering, given that JP 10077438 disclose an identical type and amount of pigment particle as presently claimed, i.e. mica coated with titanium oxide or iron oxide, it is clear that the ink is inherently glittering.

The difference between JP 10077438 and the present claim is the requirement in the claim of binder.

EP 600205, which is drawn to ink comprising water, solvent, water-soluble resin, colorant, and pearlescent pigment as is JP 10077438, disclose that it is conventional to add water-soluble binder to such inks (page 3, lines third full paragraph, lines 3-4 and 8-9).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use binder in the ink of JP 10077438 in order to improve adhesion of the ink to substrate, and thereby arrive at the claimed invention.

### **Response to Arguments**

9. Applicants' arguments with respect to JP 07118592 have been considered but they are moot in view of the discontinuation of this reference against the present claims.

10. Applicants' arguments filed 1/28/03 have been fully considered but they are not persuasive.

Specifically, applicants' argue that there is no disclosure in JP 10077438 of ratio of smoothness on the particle surface to the median diameter or surface coating ratio of the colorant as presently claimed. However, it is noted that there is no requirement in present claim 27 regarding either the ratio of smoothness on the particle surface to the median diameter or surface coating ratio of the colorant. It is noted that claim 28, which depends on claim 27 and does require such ratios, is not rejected by JP 10077438.

Applicants also argue that there is no disclosure in JP 10077438 of binder as presently claimed. It is agreed that there is no disclosure in JP 10077438 of binder which is why the reference is now used in combination with EP 600205 which discloses that it is conventional to use binders in inks such as those disclosed by JP 10077438.



Applicants also argue that while pearlescent pigments such as those disclosed by JP 10077438 are glittering pigments, they do not possess strong glittering feeling or spatial effect found in the glittering particles of the present invention.

However, it is noted that claim 27 only requires that the ink comprises glittering particle. There is no requirement in claim 27 regarding the strength of the glittering feeling or the spatial effect exhibited by the glittering particles.

Thus, given that JP 10077438 disclose, by applicants' own admission (page 1, lines 24-25 and page 8, lines 3-4 and 12), glittering pigment, it is the examiner's position that JP 10077438 remains a relevant reference against present claim 27.

**NOTE:** If applicants were to substitute the limitations of claim 28 into claim 27, the examiner would withdraw the rejection of record against claim 27.

**Allowable Subject Matter**

11. Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 28 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims given that there is no disclosure or suggestion in EP 600205, JP 10077438, or JP 07118592 of the ratio of smoothness on the particle surface to the median diameter of the glittering particle or any disclosure or suggestion of the surface coating ratio of the colorant covering the surface of the glittering particle's (i.e.

pearlescent pigment) surface as required in the present claim 28 and thus, no disclosure that the ratio of smoothness on the particle surface to the median diameter is not greater than 0.011 or that the surface coating ratio is not greater than 80% as presently claimed.

In the previous rejections of record, the examiner argued that the ratio of smoothness on the particle surface to the median diameter and the surface coating ratio of the colorant covering the surface of the glittering particle's surface were inherent to the pigments of each of EP 600205, JP 10077438, and JP 07118592. However, upon reconsideration and in light of the disclosures on pages 1-2 and 6 of the present specification, it is clear that there is no basis or evidence to support the position that the ratio of smoothness on the particle surface to the median diameter and the surface coating ratio of the colorant covering the surface of the glittering particle's surface are inherent features of any of the cited references.

Specifically, the paragraph bridging pages 1-2 of the present specification discloses that conventional glittering pigments including pearlescent pigments, which are the pigments disclosed by either EP 600205, JP 10077438, or JP 07118592, do not possess strong glittering feeling and spatial effect. Further, page 6 of the present specification discloses that even when the median diameter of the glittering particles is not less than 10  $\mu\text{m}$ , as is the case in each of EP 600205, JP 10077438, and JP 07118592, when the ratio of smoothness on the particle surface to the median diameter exceeds 0.011, the glittering feeling lowers. Further, page 6 discloses that when the surface coating ratio of the colorant covering the surface of the glittering particles exceeds 80%, the glittering feeling also lowers. Thus, it is the ratio of smoothness on the particle surface to the median diameter and/or the surface coating ratio of the colorant covering the

surface of the glittering particle's surface that define the glittering particles of the present invention.

In light of the above and none of EP 600205, JP 10077438, and JP 07118592 discloses or suggests the ratio of smoothness on the particle surface to the median diameter and the surface coating ratio of the colorant covering the surface of the glittering particle's surface as presently claimed, it is clear that the glittering particles of each of EP 600205, JP 10077438, and JP 07118592 do not meet the requirements of present claim 28. That is, while each of EP 600205, JP 10077438, and JP 07118592 discloses glittering particles, they are not the glittering particles required in the present claim which must possess the ratio of smoothness on the particle surface to the median diameter and/or the surface coating ratio of the colorant covering the surface of the glittering particle's surface as required in present claim 28.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Application Number: 09/665,534

Art Unit: 1714

Page 11

CS

April 21, 2003

A handwritten signature in cursive script, reading "Callie E. Shosho".

Callie E. Shosho

Examiner

Art Unit 1714